

Rejection Under 35 USC § 101, below, apply equally here). Furthermore, the Examiner admits claims “to data structure[s] stored on a computer readable medium that increases computer efficiency [was] held statutory” in *In re Lowry*, 32. F.3d 1579, 15834-84, 32 USPQ 2d 1031, 1035 (Fed.Cir. 1994). As such, no such “active step of utilizing data to produce a tangible result” is required. As such, claims 79-88 (and claims depending therefrom) are believed to be in a condition for allowance.

Rejection Under 35 USC § 101

Claims 18-34 have been rejected under 35 U.S.C. § 101, as allegedly being directed to non-statutory subject matter. The Examiner alleges that the claims are of a type likened to "nonstatutory music [which] is not a computer component and it does not become statutory by merely recording it on a compact disk...." The Examiner concludes, “[p]rotection for this type of work is provided under the copyright law.” Applicant has made amendments, but not for purposes of patentability. Applicant asserts that previous versions of the claims are patentable, but has made changes to concentrate on claim variations that are more desirable at this time. Applicant reserves the right to pursue previous claim variations at a later date. Insofar as the amendments are not made for purposes of patentability, Applicant respectfully traverses the rejection

Applicants respectfully disagree and submit that in one embodiment, the pending and previous claims are directed to a medium that is readable by a program or processor which may be used to populate a database, receive a request, select demand information and generate a report. This (e.g., the furthering and enabling of a generation of a report) certainly does achieve a useful, concrete, and tangible result. Further, Applicants submit that the § 101 rejections raised by the Examiner are rendered moot in view of Ex Parte Lundgren ("Lundgren"), Appeal No.

2003-2088 issued by the Board of Patent Appeals and Interferences ("BPAI"). In Lundgren, the BPAI reversed a 35 U.S.C. § 101 rejection based on the examiner's application of a separate "technological arts" test from *In re Musgrave* (See, Lundgren, page 7). In Lundgren, the BPAI establishes that "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." (See, Lundgren, page 9). Accordingly, Applicants submit that the 'technological arts' test should not be applied to the pending claims and therefore request withdraw of this ground of rejections. As such, claims 18-34 (and claims depending therefrom) are believed to be in a condition for allowance.

Rejection Under 35 USC § 103

Claims 1,4-7,9-11,18,21-24,35, and 38-41 have been rejected under 35 U.S.C. § 103 as being unpatentable over Prime Response, Inc. (a collection of prior art cited in PTO-892, Items: U and V, hereinafter referred to as "PRIU" and "PRIV," respectively, and "PRI," collectively) in view of IQ Software (PTO-892, Item: W, hereinafter referred to as "IQS") (collectively, the "references"). Applicant respectfully traverses the rejection.

With regard to claim 1, 18, 35 (and claims depending therefrom), the references do not disclose several elements that are recited in the claims. The references do not disclose:

- receiving a request specifying criteria for selecting collected commerce information, said criteria generated from a user's selections made within a user interface;
- selecting demand information from collected commerce information based on the user's selections; and
- generating a report of the demand information for the goods or services based on the user's selections, wherein the demand information includes current demand levels for the goods or services

The Examiner is using impermissible hindsight to ascribe and interpret various features to the references that are not present in the references. Further, the Examiner asserts that

the references teach various features that are not aligned to claim elements (See, Office Action page 6-7, 10-12, et al.). The Examiner then draws conclusions from these asserted features (which are not aligned to claim elements) as somehow having satisfied not-mentioned claim elements (See, Office action page 7-8, 11, 12-13). For example, the Examiner asserts that the list of underlined features on pages 6-7 of the Office Action somehow teaches “a) conditional purchase offers...b) marketers leveraging customer behavior...and c) sharing customer and campaign information...but does not disclose generating a demand report.” It is not clear if Applicant should interpret these Examiner generated features (a, b and c) as somehow satisfying the claimed elements of “populating a database...receiving a request...selecting demand information.” If so, it is unclear how or which Examiner generated features a), b) and c) satisfy any of the claimed “populating a database...receiving a request...selecting demand information” elements; and as such, Applicant respectfully requests that the Examiner more particularly point out how these Examiner asserted features satisfy the claimed elements as claimed. Nevertheless, Applicant asserts that these Examiner asserted features do not satisfy the claimed elements.

In particular, nothing in the PRIU mentions the “select[ion] of demand information...based on user’s selection.” The PRIU reference allows “priceline.com to personalize aspects of its Web site on the fly to suit particular needs of individual customers” apparently through the combination of priceline.com’s system with Prime@vantage.com software. (See, PRIU page 2 ¶3). This “personaliz[ation]” in no way teaches the “select[ion] of demand information...based on user’s selection.” First, this personalization is silent on how it may relate or otherwise connect to demand information, and second, this personalization is not based on a user’s selection. Similarly, the PRIV reference is equally silent on “select[ion] of demand information...based on user’s selection.” PRIV combines “Prime Vantage™ marketing

automation solution with...DecisionSuite® and MyEureka!(TM).” (See, PRIV page 2 ¶2 (¶ starting with “The National Conference...” text)). The PRIV reference goes on to note that the combination of the “Prime Vantage™ marketing automation solution with...DecisionSuite® and MyEureka!(TM)” results in “the industry's first fully integrated data analysis and campaign management solution designed to scale to the enterprise – [the] solution will enable marketers to tightly couple in-depth customer data with campaign planning and execution.” A campaign management solution does not in anyway teach “select[ion] of demand information...based on user’s selection.” This combination is then purportedly somehow integrated with DynaMark’s APEX(SM) customer Management and Analysis System to result in a combination of “automated campaign management with advanced Web-based analysis.” (See PRIV, page 2 ¶3).

The PRIV reference goes on to note that “[t]his combined technology enables us to offer our clients an important competitive edge via Web-based analysis and quick reaction to market trends...by [i]ntegrating these two leading marketing applications offers us the flexibility and control required to execute highly responsive one-to-one marketing strategies [and as] a result, DynaMark can deliver more targeted holistic marketing campaigns to clients.” (See PRIV, page 2 ¶5). Even assuming that the “Prime@vantage.com” software noted in PRIU is the same as the “Prime Vantage™ marketing automation solution” in the PRIV references, there is still i) no motivation to combine the DecisionSuite and/or the APEX product back into the priceline.com system, ii) it still does not teach the element of “select[ion] of demand information...based on user’s selection,” iii) would not result in the claimed invention. Again, this purported combination of the Prime Vantage and DynaMark’s products back into the PRIU reference does not in any way teach the claimed element of “select[ion] of demand information...based on user’s selection.” Thus, even if there were motivation to combine the PRIV reference back into

the PRIU reference (and there is no such motivation), as the element of “select[ion] of demand information...based on user’s selection” is still absent, such a combination would still not result in the claimed invention.

Consequently, as each of the cited references fails to teach the claimed element of “select[ion] of demand information...based on user’s selection,” any combination resulting from the cited references will fail to be capable of that claimed element and, as such, will not result in the invention as claimed. Furthermore, none of the other references cited by the Examiner with regard to subsequent and/or remaining claims address the element of “select[ion] of demand information...based on user’s selection.” More particularly, none of the other cited references, the IQS, Walker (US 6,041,308), or Official Notice address the element of “select[ion] of demand information...based on user’s selection.” As such, Applicant asserts that remarks made with regard to claims 1,4-7,9-11,18,21-24,35, and 38-41 (and claims depending therefrom) apply, similarly to Examiner rejections of claims 2,8,12-17,19,25-34,36,42-51,79-92, 94-97 (and claims depending therefrom) and claims 3, 20, 37, 76-78, 93, and 98-107 (and claims depending therefrom).

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-51 and 76-107, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the

above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-092.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is

hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-092

Respectfully submitted,
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